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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,796	11/18/2003	Anthony J. Baerlocher	0112300-1807	4561
29159	7590	04/19/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,796

Applicant(s)

BAERLOCHER, ANTHONY J.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 9,40,56 and 79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-39,41-55,57-78 and 80-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/18/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Examiner acknowledges receipt of amendment on 1/27/05. In response to the restriction requirement, applicant has elected Species 1, claims 8, 39, 55 and 78, with generic claims 1-7, 10-38, 41-54, 57-77, and 80-97 for examination purposes. Claims 1-8, 10-39, 41-55, 57-78, and 80-97 will be considered, and claims 9, 40, 56 and 79 are withdrawn from consideration. Claims 1-97 are pending.

### ***Claim Objections***

1. Claims 1, 27, 70-71, 92-94 are objected to because of the following informalities:
  - a) In claim 1, the item (e) should be corrected to (d).
  - b) In claim 27, line 2, the "tat" should be corrected to "at".
  - c) In claim 70, line 2; claim 92, line 2, the claimed limitation "(a) to (c)" should be corrected to "(a) to (d)".
  - d) In claim 71, line 6, the "; and" should be corrected to ";;"
  - e) In claim 93, line 8; and claim 94, line 9, the claimed limitation "selection set" should be corrected to "selection sets".

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-97 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of U.S. Patent No. 6,663,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-97 of the present application disclose similar subject matter taught in claims 1-59 of patent '489 in a broader scope by eliminating some limitations such as the processor. Further, including a trigger event in a game would have been well known to a person of ordinary skill in the art at the time the invention was made.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-39, 41-55, 57-78, and 80-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al (US. Patent No. 6,190,255) in view of Vancura (US. Patent No. 6,852,028).

As per claim 1-2, 10-11, 14-15 and 20, Thomas discloses a gaming device comprising a game (col. 3, lines 46-48); a selection set, a plurality a awards associated with the selections, a display device for displaying the selections (Fig. 8; col. 9, lines 58-67; and col. 10, lines 1-3); and a trigger event (col. 5, lines 22-28), when the trigger event occurs, the player can pick a selection (col. 10, lines 25-46), and the player is provided the award associated with the picked selection (col. 12, lines 44-48). Thomas does not explicitly disclose reducing the number of selections and allowing the player to pick from the reduced number of selections. However, Vancura discloses not to allow the player to pick the selections that have already been picked (col. 3, lines 51-59). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to reduce the number of available selections so that

the player cannot pick the selections that have been selected in order to encourage the player to try new selections.

As per claim 3-4, Vancura discloses providing a predetermined number of generations of the award distributor (col. 3, lines 19-50).

As per claim 5, Vancura discloses including an additional generation (col. 5, lines 36-38).

As per claim 6-8 and 19, providing an additional generation when the trigger event occurs and there are no selections available to be picked, displaying the awards separate from the selections, randomly associating the awards with the selections, and reassigning awards associated with the remaining selections would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 12, Thomas discloses accumulating the awards (col. 12, line 45).

As per claim 13 and 16-18, removing a selections from a display and reducing a number of selections by a randomly determined number of selections or by a number of selections picked by the player would have been both well known and obvious design choice.

As per claim 21, 23-24, and 27-28, refer to discussion in claim 1 above. Further, Vancura discloses a plurality of selection sets (col. 5, lines 1-38).

As per claim 22, refer to discussion in claim 2 above.

As per claim 25-26 and 29-30, setting probability associated with one selection set higher than the probability associated with other selection sets would have been both well-known and obvious design choice according to designer's preference.

As per claim 31-35, refer to discussion in claims 3-5 and 21 above.

As per claim 36-39, 41-52, 55, and 57-67, refer to discussion in claims 1, 6-8, 10-20, 13-18 and 25.

As per claim 53-54, allowing the player to pick selections until the selection set is exhausted, and setting the same trigger event would have been well known and obvious design choice.

As per claim 68-70, operating a game via Internet network, and storing a method game in a memory would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 71, refer to discussion in claim 21 above.

As per claim 72-73, Vancura discloses allowing the player to pick a selection from other selection set upon occurrence of another different trigger event (secret passage to weapon screen, room screen in col. 5, lines 9 and 17) (col. 5, lines 35-38).

As per claim 74-78 and 80-97, refer to discussion in claims 1, 7-8, 10-13, 15-19, 24-25, 35, 68-70, 72-73.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 703-872-9306.

kn  
Date: April 14, 2005



Kim Nguyen  
Primary Examiner  
Art Unit 3713